

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of

Conf. No.: 2311

CAMPBELL et al.

Atty. Ref.: 3638-896 (AMK)

Serial No. 10/594,666

TC/A.U.: 3634

Filed: September 28, 2006

Examiner: D. Cahn

For: MAST LIFT MACHINE

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April 1, 2011

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

In reply to the Examiner's Answer dated February 1 2011, Appellants submit this Reply Brief under 37 C.F.R. §41.41.

In the Grounds of Rejection set forth in the Examiner's Answer, the Examiner sets forth modified grounds, providing an alternative "interpretation" of the phrase "machine weight." The Examiner provides that reference to the machine weight "could be interpreted as any element which is inherently less than 200 pounds of the lift of Fig. 1; to explain more clearly, the wheel at 13 or the back post 15 in fig. 2, etc. . . . are inherently 'a weight' respectively and inherently use their weight to provide a counterbalance to the platform lift." Appellants respectfully take issue with the new grounds of rejection.

Claim 20 specifies that “a machine weight of the assembled mast lift is less than 200 pounds.” It is not clear to Appellants how any interpretation of this language could be remotely met by a *single part* of the Thevenot structure.

In the Response to Argument section in the Examiner’s Answer, the Examiner misquotes the language from independent claim 20, contending that claim 20 “does not claim that the entire mast lift is less than 200 pounds. . . .” As noted, however, claim 20 recites that “a machine weight of the assembled mast lift is less than 200 pounds.” Moreover, claim 1 recites that “a machine weight of the mast lift is less than 200 pounds.” Appellants submit that those of ordinary skill in the art would readily understand that reference to “a machine weight of the mast lift” refers to the entire mast lift.

The Examiner subsequently questions the accuracy of the evidence relating to the weight of the Thevenot structure. Appellants note that the evidence was prepared based on engineering principles by the inventors herein and associates of the inventors using information available to them. At a minimum, it should be clear that the Thevenot structure would have a machine weight substantially exceeding 200 pounds.

The Examiner further contends that the “point at hand is that it would have been obvious to one of ordinary skill in the art to modify the structure of Thevenot [to have a machine weight of less than 200 pounds].” As discussed previously, however, such a modification would require substantial engineering that is neither disclosed nor remotely suggested in the Thevenot patent. Even under the Supreme Court’s holding in *KSR v. Teleflex*, there must be some apparent reason to make the modification proposed by the

Examiner aside from merely meeting the claims of the invention. Moreover, it must be clear that an ordinary skilled artisan would have known how to make the proposed modification. See, for example, *Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335 (Fed. Cir. 2009). In the context of the Thevenot structure, Appellants have demonstrated that such modifications, although idealistic, are structurally impossible.

For the reasons discussed herein and in the Appeal Brief, reversal of the rejections is respectfully requested.

Respectfully submitted,

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